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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,703	03/30/2004	Ralph E. Wesinger JR.	GRAPH-005COD	8091
28661 7590 05/19/2008 LEWIS AND ROCA, LLP 1663 Hwy 395, Suite 201 Minden, NV 89423				
EXAMINER				
HAQ, NAEEM U				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/813,703

**Applicant(s)**

WESINGER ET AL.

**Examiner**

Naeem Haq

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-10 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-5 and 7-10 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to the Applicants' amendment filed on March 17, 2008. Claims 1-5 and 7-10 are pending and will be considered for examination.

### ***Affidavit***

The affidavit/declaration of Ralph E. Wesinger, Jr. filed on May 2, 2008 under 37 CFR 1.131 has been considered but is ineffective to overcome the Montulli reference for the following reason(s):

The evidence submitted is insufficient to establish an actual reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Montulli (US 5,774,670) reference. An actual reduction to practice requires a showing of the invention in a physical or tangible form that shows every element of the count. See *Wetmore v. Quick*, 536 F.2d 937, 942, 190 USPQ 223, 227 (CCPA 1976). For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development. If a device is so simple, and its purpose and efficacy so obvious, construction alone is sufficient to demonstrate workability. *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 860, 226 USPQ 402, 407 (Fed. Cir. 1985); (Also see MPEP 715.02 and 715.07) In the present case, the evidence submitted by the applicants fails to show the following limitations:

"...said page including an icon for invoking a purchase process";

"...thereby invoking said purchase process";

"creating a Transaction ID corresponding to said purchase process";

"storing...purchase information in said database";

Moreover, it has been held that *"The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged...A general allegation that the invention was completed prior to the date of the reference is not sufficient. Ex parte Saunders, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131...An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. Ex parte Ovshinsky, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989)...The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974)." (see MPEP 715.07).*

In addition, it has been held that *"...a party seeking to establish an actual reduction to practice must satisfy a two-prong test: (1) the party constructed an embodiment or performed a process that met every element of the interference count, and (2) the embodiment or process operated for its intended purpose." Eaton v. Evans, 204 F.3d 1094, 1097, 53 USPQ2d 1696, 1698 (Fed. Cir. 2000)...The same evidence sufficient for a constructive reduction to practice may be insufficient to establish an actual reduction to practice, which requires a showing of the invention in a physical or tangible form that shows every element of the count. Wetmore v. Quick, 536 F.2d 937, 942, 190 USPQ 223, 227 (CCPA 1976).*

*The device reduced to practice must include every limitation of the count. Fredkin v. Irasek, 397 F.2d 342, 158 USPQ 280, 285 (CCPA 1968); every limitation in a count is material and must be proved to establish an actual reduction to practice. Meitzner v. Corte, 537 F.2d 524, 528, 190 USPQ 407, 410. See also Hull v. Bonis, 214 USPQ 731, 734 (Bd. Pat. Inter. 1982) (no doctrine of equivalents-remedy is a preliminary motion to amend the count to conform to the proofs)." (see MPEP 2138.05)*

### **Priority**

Applicants' claim to priority to co-pending applications (10/703,823), (09/952,985) (09/110,708) and (08/572,543) is denied because the invention claimed in the current application lacks support in these earlier filed applications. Accordingly, the examiner will use the filing date of the current application (March 30, 2004) as the earliest priority date of the claimed invention.

Referring to claim 1: The limitations lacking proper support in the earlier filed applications are as follows:

"...said page including an icon for invoking a purchase process";

"...thereby invoking said purchase process";

"creating a Transaction ID corresponding to said purchase process";

"storing...purchase information in said database";

Application 08/572,543 (US Patent 5,778,367) (hereafter referred to as "367") is directed to electronically publishing information (col. 2, lines 58-66). Patent 367' discloses that a user is presented with a main page Figure 2A that has icons which may be clicked on to select different services (col. 4, lines 39-50). These services include "Whois", "Traceroute", and "WebBook". Patent 367' also discloses that "Whois" is an

Internet service that looks up information in a database (col. 6, lines 44-48), and that "Traceroute" is a program that allows a user to find the path a packet takes as it crosses the Internet to a specific destination (col. 6, lines 48-51). Neither of these services invokes a purchase process or creates a Transaction ID. The last service disclosed by Patent 367' is "WebBook". The 367' specification describes "WebBook" as a service that allows a user to search, add, or update entries in a database (col. 4, lines 42-43; col. 7, lines 33-38). The specification goes on to teach that if the service is based on a pay-for service model then the system will charge the user's credit card (col. 9, line 66 – col. 10, line 9) for using the service. However, the examiner notes that the icon on Figure 2A does not represent a purchase process, and that the step of clicking on the icon does not, by itself, invoke a purchase process but instead invokes a process to allow a user to search, add, or update entries in a database. Finally, the 367' specification discloses that a Transaction ID is created when the user chooses to add a new entry to the database (col. 6, lines 16-19; col. 9, lines 24-27: *"When the user chooses to add a new entry to the database, a unique transaction ID is created for that entry, to be used throughout the life of the entry."*) Thus, the specification makes it clear that the Transaction ID is created in response to a new entry and not in response to a purchase process as recited in claim 1 of the current application. For these reasons, the limitations noted above are denied priority and will be accorded a filing date of March 30, 2004.

### ***Specification***

The amendment filed March 17, 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Claim 1 recites the following limitations that lack written description support in the specification:

*"...said page including an icon for invoking a purchase process";*

*"...thereby invoking said purchase process";*

*"creating a Transaction ID corresponding to said purchase process";*

*"storing...purchase information in said database";*

These limitations lack written description in the specification. Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Final Rejection***

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 and 7-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. Claim 1 recites the following limitations that lack written description support in the specification:

*"...said page including an icon for invoking a purchase process";*

*"...thereby invoking said purchase process";*

*"creating a Transaction ID corresponding to said purchase process";*

*"storing...purchase information in said database";*

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1-5, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montulli (US 5,774,670) in view of Deaton et al. (US 5,621,812) ("Deaton").**

Referring to claim 1: Montulli discloses a method for facilitating an online transaction comprising:

- providing a web site having an associated database (col. 4, line 50 – col. 5, line 10; Figure 1B, item "137")
- associating, by the web site, a user ID with a user (col. 7, lines 45-55; col. 10, lines 25-30);
- presenting to the user a page, said page including an icon for invoking a purchase process (col. 12, lines 11-27);



- clicking on said icon by the user, thereby invoking said purchase process (col. 12, lines 28-47);
- creating a Transaction ID corresponding to said purchase process (col. 12, lines 49-56);
- associating, by said purchase process: customer information corresponding to said User ID; purchase information corresponding to said Transaction ID (col. 13, lines 24-30); and
- completing said purchase process (col. 13, lines 9-23).

Montulli does not teach storing the Transaction ID in the database associated with the web site. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to relocate the Transaction ID of Montulli to the database associated with the web site, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Montulli also does not teach storing customer and purchase information in the database. However, Deaton discloses a method and system for building a database for incentive marketing wherein the customer and purchase information are stored in a database (Abstract; col.4, lines 31-46; col. 5, lines 62-65; col. 56, line 24 – col. 57, line 36; col. 64, lines 40-64). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Deaton into the invention of Montulli. One of ordinary skill in the art would have been motivated to do so in order to enable merchants to issue coupons and other inducements to customers based upon

the shopping habits of the customer and to reward a high volume shoppers, as taught by Deaton (col. 64, lines 51-57).

Referring to claim 2: The cited prior art teaches or suggests all the limitations of claim 1 as noted above. Furthermore, Montulli teaches that the page comprises mini homepage corresponding to said user (col. 7, lines 45-55).

Referring to claims 3 and 4: The cited prior art teaches or suggests all the limitations of claim 2 as noted above. The cited prior art does not teach that the mini homepage includes customer information corresponding to the user, or that the customer information comprises credit card information corresponding to said user. However, the Examiner notes that these limitations are not functionally involved in the steps or elements of the recited or apparatus. Therefore these limitations are deemed to be nonfunctional descriptive material. The steps of method would be performed the same regardless of what information the homepage contained. The difference between the content of the Applicants' homepage and the prior art is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information in the homepage of Montulli because such information does not functionally relate to the elements of the claimed system and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claim 5: The cited prior art teaches or suggests all the limitations of claim 4 as noted above. Furthermore, Montulli teaches that the online transaction is completed using the credit card information (col. 13, lines 9-23).

Referring to claims 9 and 10: The cited prior art teaches or suggests all the limitations of claim 3 as noted above. Montulli does not teach that the mini homepage includes content predefined by the user, or that said information includes an email address corresponding to said user. However, the Examiner notes that these limitations are not functionally involved in the steps or elements of the recited or apparatus. Therefore these limitations are deemed to be nonfunctional descriptive material. The steps of method would be performed the same regardless of what information the homepage contained. The difference between the content of the Applicants' homepage and the prior art is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information in the homepage of Montulli because such information does not functionally relate to the elements of the claimed system and because the subjective interpretation of information does not patentably distinguish the claimed invention.

**Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montulli (US 5,774,670) in view of Deaton et al. (US 5,621,812) ("Deaton") and further in view of Official Notice.**

Referring to claim 7: The cited prior art teaches or suggests all the limitations of claim 3 as noted above. The cited prior art does not teach that the information may be updated by the user. However, Official Notice is taken that it is old and well known in the art for a user to update information. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate an updating feature into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to allow a user to modify his her profile.

Referring to claim 8: The cited art teaches or suggests all the limitations of claim 7 as noted above. The cited prior art does not teach that the update may only be performed receiving a proper password form the user. However, Official Notice is taken that it is old and well known in the art to allow updating only after receiving a proper password from a user. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to secure a user's personal information.

### ***Response to Arguments***

Applicants' arguments have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Naeem Haq/  
Primary Examiner, Art Unit 3625

May 13, 2008